

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 13-18 and 31-41 are pending in the application, with 13, 31 and 37 being the independent claims. Claims 1-6 and 19-24 are sought to be cancelled without prejudice to or disclaimer of the subject matter recited therein. Claims 7-12, 25-30 and 42 were previously cancelled without prejudice to or disclaimer of the subject matter recited therein. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Rejections under 35 U.S.C. § 102

The Examiner has rejected claims 1-6 and 19-24 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,974,150 to Kaish *et al.* (hereinafter "Kaish"). By the foregoing amendments, claims 1-6 and 19-24 have been cancelled without prejudice to or disclaimer of the subject matter recited therein, thereby rendering the rejection of these claims moot. Accordingly, Applicants respectfully request that the rejections of claims 1-6 and 19-24 be reconsidered and withdrawn.

The Examiner has rejected claims 13-17 and 31-35 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,069,955 to Coppersmith *et al.* (hereinafter "Coppersmith"). Based on the following comments, Applicants respectfully traverse.

As previously presented, claim 13 recites a method of identifying counterfeit articles that includes the steps of:

reading a first pattern and a second pattern;
converting said first pattern and second pattern into a corresponding first data set and second data set; and
comparing said first and second data sets to each other.

Coppersmith does not teach each and every feature of claim 13. For example, as set forth in the Amendment and Reply dated November 1, 2004, Coppersmith does not teach or suggest "comparing said first and second data sets to each other." Regarding this Amendment and Reply with respect to Coppersmith, the Examiner directs Applicants to Coppersmith at column 3, lines 52-58, in which Coppersmith discloses "examining the visible label **using** public key 109." However, Applicants respectfully assert that the Examiner's citation fails to provide the appropriate teaching in light of the amendments made to claim 13 in the Amendment and Reply dated November 1, 2004.

As previously presented, claim 13 recites a method of identifying counterfeit articles in which a first and second pattern are converted into a first and second data set, and that the first and second data set are compared to each other. In contrast, Coppersmith teaches that the authenticity of an article can be determined by examining a visible label using a public key **109** and, in a similar manner, examining a hidden label using a public key **110**. *See*, Coppersmith column 3, lines 52-58. In other words, Coppersmith teaches examining a first pattern (e.g., the visible label) in relation to a first element (e.g., public key **109**) and examining a second pattern (e.g., the hidden label) in relation to a second element (e.g., public key **110**). However, Coppersmith does not teach or suggest generating a first and second element from the visible and hidden labels, respectively, and comparing the first and second elements to each other. Accordingly,

Coppersmith does not teach or suggest "comparing said first and second data sets to each other."

The differences between the method recited in claim 13 and the teachings of Coppersmith are significant. For example, according to the method recited in claim 13, the authenticity of an article equipped with a first and second pattern can be determined through the use of a single test that uses information included in both the first and second pattern, and does not require the use of external data. Accordingly, a single test recited in claim 13 (i.e., "comparing said first and second data sets to each other") provides a dual-layer of authentication, since authenticity of an article is always based on both the first and second patterns printed on the article. In contrast, according to Coppersmith, the authenticity of an article is not always determined based on both the visible and the hidden labels. Rather, according to Coppersmith, the authenticity provided by the visible and hidden labels printed on the article is independently determined with a first and second external element (namely, public keys 109 and 110) in two separate tests; a single test does not provide a dual-layer of authentication. *See*, Coppersmith col. 3, lines 52-58.

As previously presented, claim 31 recites a system for identifying counterfeit articles, including:

means for reading a first pattern and a second pattern;
means for converting said first pattern and said second pattern into a
corresponding first data set and second data set; and
means for comparing said first and second data sets to each other.

Coppersmith does not teach or suggest each and every feature of claim 31. For example, for at least the same reasons as set for above with respect to claim 13, Coppersmith does not teach or suggest "means for comparing said first and second data sets to each other."

Since Coppersmith does not teach or suggest each and every feature of claims 13 and 31, this reference cannot anticipate those claims. Furthermore, since claims 14-17 and 32-35 depend from claims 13 and 31, respectively (and therefore contain each and every feature of claims 13 and 31, respectively), Coppersmith does not teach or suggest each and every feature of those claims. Therefore, Applicants respectfully request that the rejections of claims 13-17 and 31-35 be reconsidered and withdrawn.

The Examiner has rejected claims 37-38 and 40-41 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,748,533 to Wu *et al* (hereinafter "Wu"). Based on the following remarks, Applicants respectfully traverse.

As previously presented, claim 37 recites a counterfeit resistant article that includes:

a first randomly-generated marking readable to generate a first data set;
and
a second marking readable to generate a second data set, wherein said first data set and said second data set are related according to a predefined relationship.

In the Amendment and Reply dated November 1, 2004, Applicants set forth that Wu does not teach each and every feature recited in claim 37. For example, Applicants previously argued that Wu does not teach or suggest using a "randomly-generated marking to generate a first data set." In response to Applicants' argument, the Examiner directs Applicants to Wu col. 12, lines 58-67 where the "'Name of Country' is encrypted and an encrypted set of data is a randomly generated set of data." While this may be true, Applicants respectfully submit that the Examiner's statement is misdirected—in particular, claim 37 recites a "randomly-generated **marking**," not a randomly-generated **data set**. Although, as the Examiner points out, Wu may teach a marking printed on an

article (i.e., "Name of Country") that can be encrypted into a randomly-generated data set, Wu does not teach or suggest "a randomly-generated marking" printed directly on the article. In other words, "Name of Country" itself is not "a randomly-generated marking."

Since Wu does not teach or suggest each and every feature of claim 37, it cannot anticipate this claim. Furthermore, since claims 38 and 40-41 depend from claim 37 (and therefore contain each and every limitation of claim 37), Wu does not teach or suggest each and every feature of those claims. Therefore, Applicants respectfully request that the rejections of claims 37-38 and 40-41 be reconsidered and withdrawn

Rejections under 35 U.S.C. § 103

The Examiner has rejected claims 18 and 36 under 35 U.S.C. § 103(a) as being unpatentable over Coppersmith as applied to claims 13 and 31, and further in view of U.S. Patent No. 5,867,586 to Liang (hereinafter "Liang"). Applicants respectfully traverse based the following remarks.

As submitted above, Coppersmith does not teach or suggest each and every limitation of claims 13 and 31, and further Liang does not provide the missing teaching or suggestion. Liang is directed toward an authentication system that combines a source of ultraviolet light with an apparatus for capturing and recognizing either graphic images or characters or both. In particular, Liang teaches marking an article "with fluorescent indicia" and using an ultraviolet light source to "illuminate articles to be tested for authenticity." *See* Liang, column 5 line 67 and column 5 line 52, respectively. Liang is conspicuously silent on the issues of "comparing said first and second data set to each

other" and "means for comparing said first and second data set to each other," as recited by claims 13 and 31, respectively.

Since Liang and Coppersmith, alone or in combination, do not teach or suggest each and every limitation of independent claims 13 and 31, the references cannot render the respective dependent claims 18 and 36 obvious. Accordingly, the Examiner's rejections of claims 18 and 36 under 35 U.S.C. § 103(a) are traversed and Applicants respectfully request that these rejections be reconsidered and withdrawn.

The Examiner has rejected claim 39 under 35 U.S.C. § 103(a) as being unpatentable over Wu as applied to claim 37, and further in view of Liang. Based on the foregoing claim amendments and the following remarks, Applicant respectfully traverses.

The above-described shortcomings of Wu with respect to claim 37 are not remedied by the teachings of Liang. For example, Liang does not teach "a first randomly-generated marking readable to generate a first data set." In fact, Liang teaches an authentication system that uses "a predetermined set of graphic images and characters." *See* Liang, column 4 lines 45-46.

Since Wu and Liang, alone or in combination, do not teach or suggest each and every feature of independent claim 37, the combination of Wu and Liang fail to support a *prima facie* obviousness rejection of this claim. Furthermore, dependent claim 39 is also not rendered obvious by the combination for at least the same reasons as the independent claim 37 from which it depends and further in view of its own features. Accordingly, the Examiner's rejection of claim 39 under 35 U.S.C. § 103(a) is traversed and Applicants respectfully request that this rejection be reconsidered and withdrawn.

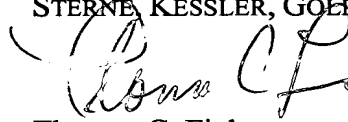
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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